

## REMARKS

Claims 1-31 are pending in the application. Claims 4, 5, 8, 9 and 18-30 have been withdrawn. Claims 1, 16, and 31 have been amended in this paper. Applicant asks the examiner to kindly enter this amendment.

### Claim Rejections Under 35 U.S.C. § 102 and § 103

Claims 1, 3, 6, 10 and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Prather (U.S. Patent No. 5,404,887). This rejection is respectfully traversed.

The examiner in the rejection is attempting to combine the teaching of Prather in [a] FIG. 14, and column 8, lines 45-59, describing a guidewire 74 that is unsmooth with raised surfaces 78 wherein the guidewire is loosely contained within a sleeve 76 leaving air spaces between the raised surfaces 78 and the sleeve 76, with [b] a disclosure of a “silicon oil” coating applied to a sleeve member 18 described in col. 7, lines 46-54, and shown in FIGS. 3-7 of Prather.

Amended claim 1, for example, provides “an uninterrupted polymer coating with a generally constant outside diameter adhering to and contiguous with the at least one of randomized and non-randomized tactile surface contours.” Applicant respectfully asserts that since Prather does not explicitly teach that the [b] silicon oil coating is *directly applied* to [a] the unsmooth exterior of the guidewire 74 of FIG. 14, Prather does not teach the claim element above. Accordingly, since not all elements are taught by Prather, the rejected claims are not anticipated by this reference.

Under the obviousness rejection, the examiner attempts to combine the [b] silicon oil coating with [a] the unsmooth surface guidewire. Applicant respectfully submits that this is improper based on the following.

Prather only suggests applying the silicon oil coating to the exterior of the *sleeve member*, not to the exterior surface of the unsmooth guidewire core. (See Prather, col. 7, lines 46-48, “A coating may be applied to the distal 12 to 18 inches (40.6 to 45.7 cm) of the guide wire 10 approximately *corresponding to the sleeve member 18...*” emphasis added).

The examiner urges, presumably, that applying the polymer coating directly to the unsmooth guidewire core instead of the sleeve member would be obvious to one skilled in the art. However, as the examiner is aware, “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP 2143.01V.

The purpose of the raised surfaces 78 in the Prather FIG. 14 embodiment is to “*limit the amount of contact* between the exterior surface area of the guide wire 74 and the guidewire lumen wall 77. As can be clearly seen by comparing FIGS. 13 and 14, the guidewire according to the present invention *reduces the amount of surface area contact* between the exterior of the guide wire and the guide wire lumen wall.” (Prather, col. 8, lines 48-54, emphasis added.) Applying the silicon oil coating directly to the raised surfaces 78 as the examiner suggests would *increase* the surface contact between the coating and the guidewire, not decrease it as Prather requires. The examiner’s proposed combination plainly defeats a stated purpose of the Prather invention, and makes the Prather guidewire unsatisfactory for its intended purpose.

Also, the examiner has not provided a sufficient reason or explicit analysis of why the two embodiments, [b] and [a], should be combined, especially when the examiner’s combination would be contrary to the stated purpose of the invention. (See MPEP 2143 “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention

does.' KSR, 550 U.S. at \_\_\_, 82 USPQ2d at 1396. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.”)

Accordingly, it is improper for the examiner to combine the [b] polymer coating with [a] the unsmooth surface guidewire to support the *prima facie* obviousness rejection. This obviousness rejection should be withdrawn.

Claims 2, 7, and 16-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Prather (U.S. Patent 5,404,887) as applied to claim 1, and further in view of McMahon (U.S. Patent 6,296,887). Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Prather (U.S. Patent 5,404,887) as applied to claim 1 in the Office action, and further in view of Mageoh (U.S. Patent 3,731,671). Claims 12 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Prather (U.S. Patent 5,404,887) as applied to claim 1 in the Office action, and further in view of Richardson et al. (WO 01/36034). Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Prather (U.S. Patent 5,404,887) as applied to claim 1 in the Office action, and further in view of Murayama et al. (U.S. 2004/0039309). These rejections are respectfully traversed.

Independent claim 16 is patentable and nonobvious over Prather for the same reason as given above relative to claim 1, wherein the examiner attempted improperly to combine the Prather polymer coating embodiment with the unsmooth guidewire embodiment of FIG. 14.

Further, applicant has amended claim 16 to provide “a polymer coating of generally non-uniform thickness adhering without a gap to at least a portion of the distal core section with a coating profile not following a tapered profile of the elongated core.” This clearly distinguishes the claim over the Prather FIG. 1 embodiment relied on by the

examiner where there is an air gap in the lumen between the sleeve member 18 and the outside surface of the core 12.

The remaining dependent claims are patentable based on the same reasons given for the independent base claims. Applicant also respectfully disagrees with the examiner's other grounds for rejection. Based on these reasons, applicant believes the examiner has not established *prima facie* obviousness.

Claim 31 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Prather (U.S. Patent 5,404,887) in view of McMahon (U.S. Patent 6,296,616), Richardson et al. (WO 01/36034), and Murayama et al. (US 2004/0039309). This rejection is respectfully traversed.

Applicant respectfully contends that independent claim 31 is patentable and nonobvious over Prather for the same reason as given above relative to claim 1, wherein the examiner attempted improperly to combine the Prather polymer coating embodiment with the unsMOOTH guidewire embodiment of FIG. 14.

Further, applicant has amended claim 31 to provide "a polymer coating of generally non-uniform thickness adhering to and contiguous with at least a portion of the distal core section with a coating profile not following a tapered profile of the elongated core." This clearly distinguishes the claim over the Prather FIG. 1 embodiment relied on by the examiner where there is an air gap in the lumen between the sleeve member 18 and the outside surface of the core 12.

Applicant slightly amended claim 31 to correct non-substantive, typographical errors in the punctuation. Applicant also respectfully disagrees with the examiner's other grounds for rejection. Based on these reasons, applicant believes the examiner has not established *prima facie* obviousness.

## CONCLUSION

In view of the foregoing, applicant respectfully submits that all claims are now in condition for allowance. Reexamination and reconsideration of the application are respectfully requested and allowance at an early date is solicited. Applicant invites the examiner to telephone the undersigned if there are any remaining questions. It is believed that no additional fee is required for the filing of this response. However, if a fee is in fact due, the Commissioner is authorized to charge any fees or costs to our Deposit Account No. 06-2425.

Respectfully submitted,

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